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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,653	03/01/2000	Brian DOYLE	P8123	3216

7590

08/08/2002

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P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER

BEREZNY, NEAL

ART UNIT	PAPER NUMBER
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2823

DATE MAILED: 08/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/516,653

Applicant(s)

DOYLE, BRIAN

Examiner

Neal Berezny

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see advisory action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

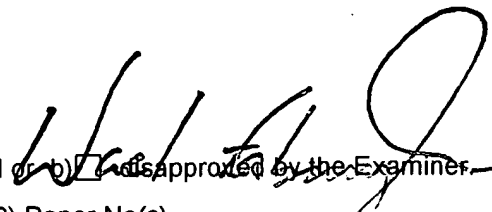
Claim(s) rejected: 1-13, 15-28 and 39-47.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☒ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

10. ☐ Other: _____


SUPERVISORY PRIMARY EXAMINER
TECHNOLOGY CENTER 2000

ADVISORY ACTION

1. The amendment filed 7/30/02 under 37 CFR 1.116 in reply to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

Allowed claim(s): None

Rejected claim(s): 1-13, 15-28, and 39-47

Claim(s) objected to: none

Response to Arguments

2. Applicant's arguments filed 7/30/02 have been fully considered but they are not persuasive. Applicant asserts that etching an SOI structure produces an SOI topology. The specifications fail to sufficiently describe or define the difference between an SOI structure and an SOI topology. Applicant must provide specific support in the specifications to overcome the rejection.

3. Applicant's arguments traversing examiner's new matter objections under 35 USC 132 are not persuasive because the original specifications described a dimensional relationship between the wire and the channels, which had changed by the plurality amendment. Further, applicant has failed to specifically cite in the original specifications where such variables are described in such a clear and unambiguous manner that would overcome the new matter objection. Applicant asserts that new matter is permitted if it is narrower in scope than the original specifications. This is

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incorrect, and would result in unlimited inclusion of new matter to very broad specifications.. Finally, applicant's citing of the specifications to support the description of item 40 is insufficient because it teaches the channel width is horizontal, and not vertical.

4. Applicant's arguments regarding examiner's 103 rejections are not convincing. The rejection stands on its own with or without the St. Regis citing. St. Regis was cited merely for additional support of the legal point. Applicant failed to address the obviousness issue. Applicant failed to respond to or add to examiner's previous response to the applicant's teaching away assertion. Further, applicant failed to comprehend examiner's arguments and erroneously concluded that the Office action had withdrawn the assertion that nitride and poly are equivalent masking materials. Applicant failed to address examiner's full arguments, disregarding the basis of the rejection.

5. Applicant attacks the references individually when the rejection is based on the combination of both the Kendall and the Chapple-Sokol references. Kendall teaches the modification of the Chapple-Sokol process to include the geometric teachings of Kendall. Applicant provides no additional support or reasoning for the assertion that Kendall's geometries are vague. Further, applicant seems to be arguing against a 102 rejection, when the rejection is a 103 rejection of two references. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long

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as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

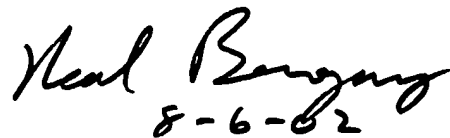
6. Finally, applicant's challenge to examiner's motivational statements is overcome by the Chapple-Sokol reference, col.1, ln.17-20.

CONCLUSION

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neal Berezny whose telephone number is (703) 305-1481. The examiner can normally be reached on Monday to Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached at (703) 308-4918. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


8-6-02

Neal Berezny

Patent Examiner

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